

REMARKS

In the Official Action, the Examiner states the application is directed to two patentably distinct inventions:

I: Claims 1-10, drawn to an adhesive composition

II: Claims 11-19, drawn to a method of making semiconductor chips.

The inventions are said to not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

The application is also said to be directed to more than one species and thereby lack unity of invention under PCT Rule 13.1. The Examiner has said that each adhesive and multifunctional monomer/oligomer combination is an independent species and requiring that one be elected in response to the selection of either Group I or Group II, based on the following examples:

a) Synthetic rubber + ethyleneglycol diacrylate

b) Acrylic adhesive + pentaerylthritol pentaacrylate

c) Synthetic rubber + ethyleneglycol diacrylate + isocyanate

Claims 1, 7, 9-11, 17 and 19 are generic.

The restrictions are respectfully traversed.

Unity of invention exists and restriction is therefore improper because the method of claim 11 is linked to the composition of claim 1 by a common inventive concept: The method of independent claim 11 requires the use of a pressure sensitive adhesive composition containing that corresponds to the same claim limitations of the composition of claim 1. Thus the restriction should be withdrawn and all claims examined.

Furthermore, the instant application is a national stage application of a PCT application filed November 17, 2003 in which the U.S. was the International Searching Authority. Section 35 U.S.C. §372(b) provides only that the Director may reexamine the question of unity of invention for applications which do not originate in the United States. In the instant situation, the PCT application did originate in the United States and the United States Patent Office was

the international searching authority. Indeed, the International Search Report, mailed April 22, 2004, bears the signature of the Examiner as the Authorized Officer and contained no objection based on unity of invention at that time. Rather, the ISR was issued based on a search of all pending 19 claims, which have not been amended since that time. For the convenience of the Examiner, a copy of the International Search Report is attached hereto.

Applicants respectfully submit that not only does the statute not provide for the reconsideration of Unity of Invention in these circumstances, but that it is improper for the same Examiner, four years later, to reconsider that decision.

MPEP 803 states:

If the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The fact that the USPTO itself has conducted a search report on all 19 claims (and all species alleged to be contained therein) without making any prior unity of invention objections is clear evidence that the search and examination of the entire application can be made without serious burden.

Put another way, there is no justification in law or fact, nor is any other basis set forth in the Restriction that explains why there is now a serious burden to search all of claims 1-19, when there was no such burden when the identical set of claims was searched four years ago and bears the signature of the Examiner now making the current restriction.

Thus, the restriction should be withdrawn and all claims of the application should be examined in full.

Notwithstanding the foregoing, and in order to comply with the restriction requirement, Applicants elect the claims of Group I (claims 1-10), with traverse. Claims 1, 7, 9 and 10 have been identified as generic within Group I. To the extent a species election is also required, Applicants elect, with traverse, the species in which the pressure sensitive adhesive is an acrylic adhesive in combination with pentaerythrytol pentaacrylate. In addition to those claims identified as generic, claims 2 and 6 read on the elected species within Group I. It is further submitted that

the species would read on claim 8, since the presence of the cross-linking agent in claim 1 is optional.

This response is filed within one month of the mailing date of the Office Action. The Commissioner is authorized to charge any fees or credit any overpayments to Deposit Account No. 50-1059. In the event any outstanding issues remain or if it would assist in the examination and allowance of the case, Applicants would appreciate the courtesy of a telephone call to Applicants' undersigned representative to resolve any such issues in an expeditious manner.

Respectfully submitted,
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